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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		1875.1410000	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number	Filed	
	09/963,671	September 27, 2001	
	First Named Inventor		
	Lisa V. Denney		
	Art Unit	Examiner	
	2623	Chowdhury, Sumaiya A.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/>	applicant/inventor.	Signature	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Robert Sokohl	
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 36,013	Typed or printed name	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	(202) 371-2600	
		Telephone number	
		August 9, 2007	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>One (1)</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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707,856



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Denney *et al.*

Appl. No.: 09/963,671

Filed: September 27, 2001

For: **Method and System for Flexible  
Channel Association**

Confirmation No.: 8981

Art Unit: 2623

Examiner: Chowdhury, Sumaiya A.

Atty. Docket: 1875.1410000

**Arguments to Accompany the Pre-Appeal Brief Request for Review**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

***Mail Stop: AF***

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

***Arguments***

Applicants' arguments in the Reply under 37. C.F.R. § 1.116 filed on June 11, 2007 in response to the Final Office Action issued on April 9, 2007, were not properly considered or responded to by the Examiner in the Advisory Action issued June 26, 2007. The Examiner's response was legally and factually deficient because the Examiner failed to show where any of the applied references teach or suggest a media access controller, including: a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications device is linked to the first communications device over a slave interface, as recited in independent claim 14.

For a rejection to be legally adequate under 35 U.S.C. § 102, every claim limitation must be taught in a single reference. *Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). The absence of any claimed element from

the reference negates anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984). For a rejection to be legally adequate under 35 U.S.C. § 103, every claim limitation must similarly be taught, or be obvious to person of ordinary skill in the art, in the combination of the references. *See Orthopedic Equipment, Inc. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983).

The Examiner rejected independent claim 14 as being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Publication No. US 2002/0144284 A1 to Burroughs *et al.* ("Burroughs") in view of International Publication No. WO 01/17167 to Hebsgaard *et al.* ("Hebsgaard"). *See*, Office Action, page 2. The Examiner relied on Burroughs and Hebsgaard to teach a media access controller, including: a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications device is linked to the first communications device over a slave interface, as recited in claim 14. Burroughs and Hebsgaard do not teach or suggest such a media access controller, and the Examiner's continued rejection based on 35 U.S.C. § 103(a) is therefore legally and factually deficient.

As is known in the art, and discussed in the Related Art section of the present application, a headend device typically has a one downstream channel and multiple upstream channels. A master-slave interface between two headend devices can be used to increment the number of upstream channels. This master-slave interface, however, typically forces all upstream channels to be associated with a single downstream channel, which leaves a downstream channel unused. The claimed invention solves this and other problems by providing a system for associating a plurality of upstream channels with a plurality of downstream channels.

The Examiner alleges that receiver 301 shown in FIG. 3 of Burroughs teaches or suggests the primary filter and the secondary filter as set forth in claim 14. *See*, Office Action, page 3. In response, Applicants assert that receiver 301 is not a filter inasmuch as "a filter is a component that filters inputs so that certain inputs are received while

other inputs are blocked" and that "Burroughs does not teach or suggest receiver 301 having filtering features." *See*, Reply, page 6. In response to Applicants' remarks, on page 2 of the Advisory Action, the Examiner states:

At the time when the primary CMTS (first communication device) is active, the primary filter (receiver 301) is used then. Thereafter, in the event of failure of the primary CMTS, the alternative CMTS (second communication device) becomes active, during which the primary filter used initially acts as the secondary filter.

It is inherent to the system of Burroughs that its filters receive bandwidth allocation messages in that the system supports DOCSIS and that it can detect downstream channels and communicates with respective CMTS.

Thus, it appears that the Examiner continues to allege that receiver 301 is a primary filter and a secondary filter as set forth in claim 14. Applicants respectfully disagree. Applicants note that the Examiner does not attempt to refute Applicants' assertion that Burroughs does not teach or suggest receiver 301 as having filtering properties. Rather, it appears the Examiner alleges that receiver 301 is a primary filter and a secondary filter and that the alleged filtering properties of receiver 301 are inherent to the system of Burroughs. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " M.P.E.P. § 2112 IV citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants assert that there is no description in Burroughs or Hebsgaard, alone or in combination, which makes it clear the receiver 301 has filtering properties. Applicants respectfully submit that the general allegation by the Examiner "that the system supports DOCSIS and that it can detect downstream channels and communicates with the respective CMTS," is not sufficient to make it clear that receiver 301 has filtering properties. Further, even assuming, *arguendo*, that the system of Burroughs does include an inherent filter, there is no extrinsic evidence that makes it clear that such a filter necessarily includes a primary and a secondary filter, as set forth in claim 14.

Moreover, claim 14 recites two filters: a primary filter and a secondary filter. The Examiner attempts to use the same component (i.e., receiver 301) to provide the teachings of both of these filters. In support of this position, the Examiner alleges that "[w]here it is recognized the invention has two distinct filters, the claims do not preclude the scenario where the first filter is used as a second filter with a different CMTS at another time." *See*, Advisory Action, page 2. Applicants respectfully disagree. Applicants note that claim 14 does not recite a single filter that acts as another filter at another time. Instead, claim 14 recites two filters. Therefore, Applicants assert that both the primary filter and the secondary filter cannot be taught or suggested by only receiver 301.

For at least these reasons, Burroughs and Hebsgaard, independently or in combination, do not teach or suggest the particular feature of a media access controller, including a filter for receiving a bandwidth allocation message from a first communication device or a second communication device, wherein said filter processes authorization instructions to authenticate said bandwidth allocation message, wherein said filter includes a primary filter for receiving a bandwidth allocation message produced by the first communications device; and a secondary filter for receiving a bandwidth allocation message from the second communications device, wherein the second communications device is linked to the first communications device over a slave interface. Because the cited references do not teach or suggest this element of claim 14, the Examiner's continued rejection of independent claim 14 over Burroughs and Hebsgaard is both legally and factually deficient.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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